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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 SAN FRANCISCO DIVISION

24 ORACLE AMERICA, INC.

25 Plaintiff,

26 v.

27 GOOGLE INC.

28 Defendant.

Case No. CV 10-03561 WHA

**ORACLE'S BRIEF REGARDING THE
IBM LICENSE**

I. IBM HAD A LICENSE TO USE THE DECLARING CODE

IBM always had a license to use the declaring code: the Technology License and Distribution Agreement. OAGOOGL0029214822. The license allows IBM to “prepare or have prepared Derivative Works of, use, modify, reproduce, and view, the Technology in Source Code Form.” *Id.* at 6. “Technology” includes “technology identified on Exhibit A.” *Id.* at 5. Exhibit A includes the “Java API Specification”—i.e. the declaring code. *Id.* at Ex. A., p.4. Accordingly, IBM had a license to use the declaring code. So the presence of declaring code in IBM products like Lotus Notes is not an example of an unlicensed use, no matter where the implementing code came from.

The license was originally for a term of ten years beginning in 1996. *Id.* at 27. Specifically, the agreement “shall continue for a period of four (4) years” and provided that IBM may extend the term for “six (6) consecutive years.” *Id.* In 2005, the provision was amended so that the term could be extended for “sixteen (16) consecutive years.” OAGOOGL0013635188 (“Amendment No. 7”). That means the term will run until 2016. The license was therefore in effect during the period of Android development, and Google knew it. TX 389 (Rubin email).

II. ANY IBM CODE IN APACHE HARMONY IS NOT RELEVANT

Google has the burden of proof to show custom. The relevant custom is the unlicensed copying of declaring code. Google claimed that IBM distributed declaring code to Harmony. That is irrelevant for two reasons. *First*, IBM using Harmony essentially to outsource writing the implementation is not the kind of custom Google needed to prove. That code is for *IBM’s* use, which was licensed. And IBM had no right to sub-license the declaring code in order to legitimize Apache.

Second, Apache *began* Harmony by taking a license: the Specification License. *See* TX 610.1. In Apache’s own words in an email to Sun, Apache “entered the specification license in good faith.” *See* ECF 1785-10 at 3. Apache’s “intention [was] always to produce a certified compatible implementation of Java SE.” *Id.* But Apache knew that “[t]o do so, we need the TCK.” *Id.* In other words, for a time, Apache was operating under a license. Any declaring code in Harmony at that time does not show an unlicensed use—whether that code came from IBM or

1 not.

2 Apache ultimately refused to accept the TCK license and distributed Harmony in violation
3 of the terms of the Specification License. *See* Oracle Motion in Limine #2 re: Apache (ECF
4 1748). IBM and others privately asked Sun to grant Apache a license, but the two sides could not
5 reach an agreement. TX 2347. After that, Sun released OpenJDK, and IBM stopped supporting
6 Harmony in favor of OpenJDK. Tr. 403:9-11 (“IBM and Intel, who were the primary contribu-
7 tors of the source code in Apache Harmony ... moved their source code contributions to Open-
8 JDK.”).

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10 Dated: May 10, 2016

Respectfully submitted,

Orrick, Herrington & Sutcliffe LLP

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12 By: /s/ Annette L. Hurst
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